UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,100	12/21/2000	Michael Osterer	7415/0G540	1500

7590 05/12/2004

Melvin C. Garner
DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER	
ENATSKY, AARON L	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/747,100	OSTERER, MICHAEL	
	Examiner	Art Unit	
	Aaron L Enatsky	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Examiner acknowledges receipt of Applicant's amendment on 2/26/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-6, 8-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. '782 (Hereafter, Walker) in view of Walker et al. '272 (Hereafter, Walker '272) in view of Walker et al. '549 (Hereafter, Walker '549). Walker teaches a group lottery game (4:1-10) system having a server, a remote computer connected through a network like the Internet (9:11-20). Walker further teaches that server stores information about the group, including player registration, group rules (9:9-39), and information relating to a particular player (2:47-56). The information regarding the desire to enter a group is apparent from a player's registration to enter a group. Walker also teaches that depending on the group rules, a winning maybe paid out to players automatically through the mail (12:5-12), or other means well known in the art (12:13-20). Additionally, a chat room is provided for group members to communicate over the Internet (13:14-16), group information can be changed over the Internet (9:31-40), and a

member could monitor other members over the Internet (13:9-1 1), and users will authenticate to the server using a password (13:7-9). Furthermore, an administrative body can set rules. Walker does not mention limitations regarding lottery information, or automatic lottery purchasing. Walker '272 teaches a lottery game using remote terminals, a central computer, to purchase a lottery ticket that will be purchased or activated based upon a user's predefined information/instructions (Abstract), where this lottery information is stored in the server database (Fig. 4), and the lottery information could include purchase interval, volume (2:48-50), and notification (4:33-36). Walker '272 also indicates entering the type of lottery ticket a player wishes to purchase (7:3-6). Both Walker and Walker '272 discuss a network system for playing a lottery, and Walker additionally teaches of player or game administrator definable rules for payout providing motivation to modify Walker to include aspects of Walker '272. Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Walker's lottery game to further include automated rule based lottery purchases providing an easier method to purchase tickets. Walker in view of Walker '272 does not however teach the limitation of a central server automatically creating groups of participants based on predefined information. Walker '549 teaches a database driven online distributed tournament system that manages all aspects of group play and participation tournaments (Abstract). Walker '549 also teaches that the central controller will automatically create player groups that are based on predefined, player-entered information (7:47-56), wherein player information includes names, addresses, ages (Fig. 3). Walker in view of Walker '272 and Walker '549 are related as network systems for facilitating group gaming activities. Wherein, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker in view of Walker

'272 with the automatically created groups taught by Walker '549 so that game play can be more fun and the central server can better allocate players among group sections (7:54-56).

In re claim 5, group information can change subsequent to logging on to the server (Walker, 13:16-22).

In re claims 6 and 13-15, given that Walker provisions for information modification as discussed above and the nature of web enabled systems as well known in the art, it would have been obvious to have a mechanism to allow modification of other information as well as the lottery information, which would provide players better control over wagers/investments.

In re claim 12, as Walker teaches chat room communication between players, instant messaging is analogous with chat room communications, and it would be inherent that the system be able to tell who is online and indicate such, to facilitate communication.

4. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Walker '272 in view of Walker '549 and further in view of Yacenda '078 (Hereafter, Yac). Walker in view of Walker '272 in view of Walker '549 (Hereafter, Wal2) teaches the claimed limitations as discussed above, but do not teach game information selection. Yac teaches a network lottery game played over the Internet where players can accesses game information (Fig. 5, 7, and 8A). One would be motivated to combine the two references as both deal with network lottery games and their administration. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wal2 to include game information so players can be advised as to what type of games are available to purchase. Furthermore, information about available lottery games are typically always available before

purchase and the web also typically associated with providing a multitude of relational information, making it obvious to one of ordinary skill in the art include game/ticket information.

Response to Arguments

5. Applicant's arguments with respect to claims 1-18 have been considered but are not considered persuasive.

Walker '782:

Applicant argues that Walker '782 is not directed to lottery games and treats the reference on an individual basis. As Examiner pointed to in the Office Action above and as acknowledged by Applicant, Walker '782 teaches that the game method described includes slots machines, lottery machines as well as other game devices. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Walker '272:

Applicant argues that Walker '782 and '272 do not teach the instant invention, which is again, not arguing the combination as a whole. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Walker '549:

Applicant argues that Walker '549 demonstrates improper hindsight by Examiner since Walker '549 is directed to a different type of group creation, i.e. groups of opposing players. Examiner believes that concept used in the rejection was that of creating groups of players based on information input in the server. Groups would automatically be created based upon user-defined parameters. The actual purpose of the groups was already taught by another reference. Again, this argument is addressing the reference individually not as a combination. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Yacenda:

Applicant argues that Yacenda differs from the present invention. Applicant also treats the reference on an individual basis. Yacenda provides no basis to teach away from the other reference or the prior art. Yacenda was used to show what was known in the gaming industry for providing information in network lottery system. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Additional elements lacking as required by claim 2:

Applicant believes that Examiner did not show all required elements as required by claim 2. Examiner has provided a further detailed explanation above of the references to show that existing references did teach the elements in question. Furthermore, a player's biographical information is considered the equivalent to e-mail, telephone, fax, and cell number. Applicant's amendment to exchange the placement of biographical information, separate from other previously designated equivalents, does not change the how the information was treated. Thus the claim requirements continue to be met by the prior art of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE

Teresa Walberg
Supervisory Patent Examiner
Group 3700